

**REMARKS**

Claims 1-4 and 7-21 are currently pending in the application. By this response, no claims are amended, added, or canceled. Reconsideration of the rejected claims in view of the following remarks is respectfully requested.

***Information Disclosure Statement dated September 6, 2005***

Applicants note that the final Office Action includes a copy of the PTO-1449 submitted with the Information Disclosure Statement (IDS) filed on September 6, 2005. The Examiner has lined-through all of the entries on the PTO-1449, indicating that these items were placed in the file but not considered. However, in the non-final Office Action dated September 14, 2006, the same PTO-1449 was initialed and signed by the Examiner, indicating consideration of all of the documents cited therein.

Due to the conflicting Office communications, Applicants respectfully request clarification as to the status of the IDS filed on September 6, 2005.

***Supplemental Information Disclosure Statement dated December 13, 2006***

Applicants note that the final Office Action gives no indication of consideration of the Supplemental IDS filed on December 13, 2006. The Supplemental IDS was filed after the mailing of the first Office action on the merits but before the mailing of the final Office Action, and the fee set forth in 37 C.F.R. §1.17(p) was paid. Therefore, consideration of the Supplemental IDS is required under 37 C.F.R. §1.97(c).

Accordingly, Applicants respectfully request consideration of the Supplemental IDS filed on December 13, 2006.

### ***35 U.S.C. §103 Rejection***

Claims 1-3, 7-12, and 16-19 were rejected under 35 U.S.C. §103(a) for being unpatentable over U.S. Patent Application Publication No. 2004/0101649 issued to Thoma ("Thoma") or U.S. Patent No. 823,843 issued to Buyten ("Buyten") in view of U.S. Patent No. 6,696,167 issued to Sean *et al.* ("Sean").

Claims 4, 13-15, 20, and 21 were rejected under 35 U.S.C. §103(a) for being unpatentable over Thoma or Buyten in view of Sean, and further in view of U.S. Patent No. 5,275,862 issued to Ramadan *et al.* ("Ramadan").

These rejections are respectfully traversed. The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations (See MPEP §2142). Applicants submit that no proper combination of the applied references teaches or suggests all of the features of the claimed invention.

*Claims 1-3, 7-12, and 16-19 in view of Thoma/Buyten and Sean*

#### Claims 1-3 and 7-10

The present invention relates to a building board for use as a ceiling or wall element. The building board comprises a plurality of oriented strand boards (OSBs) bonded together to form multiple layers. In non-limiting exemplary embodiments of the invention, interspaces are

formed between the boards of a layer. The interspaces may be left devoid of additional material, or may be filled with insulating material. Independent claim 1 recites, in pertinent part:

... a plurality of orientated strand boards (OSBs) which are disposed side by side and are bonded together in multiple layers, further comprising some interspaces filled with an insulating material and other interspaces devoid of the insulating material.

The applied references do not teach or suggest these features. More particularly, the applied references do not teach or suggest that some interspaces are filled with an insulating material while other interspaces are devoid of the insulating material.

The Examiner is of the opinion that Thoma and Buyten each show all of the features of claim 1 except for the use of OSB, that Sean teaches the equivalence of wood and wood products having OSB, and that it would have been obvious to modify Thoma or Buyten to use wood products comprising OSB. More specifically, the Examiner asserts that, in Thoma, space 6 constitutes an interspace devoid of insulating material and piece 3d constitutes an interspace filled with an insulating material. Applicants respectfully disagree.

Thoma shows a laminated wood element comprising layers 2a, 2b, 2c, 2d, etc. Each layer comprises a plurality of wood elements 3a, 3b, 3c, 3d, etc. Recesses 6 are provided between the individual wood elements 3b of a layer 2b. While recess 6 may constitute an interspace devoid of insulating material, Thoma does not show interspaces filled with insulating material. Contrary to the Examiner's assertion, board 3d does not constitute an interspace filled with insulating material. That is, board 3d constitutes part of the plurality of boards which are disposed side by side and bonded together in multiple layers. There is no interspace between the boards where board 3d resides, because board 3d is bonded to the boards adjacent to it. Thus,

because there is no interspace, there cannot arguably be an interspace filled with insulating material, as recited in claim 1.

With respect to Buyten, the Examiner has provided no explanation of how Buyten and Sean teach or suggest all of the elements recited in claim 1. In any event, Applicants submit that neither Buyten nor Sean shows some interspaces are filled with an insulating material while other interspaces are devoid of the insulating material. Buyten shows layers of connected strips c, d, e. The strips of each layer do not contact each other, but are spaced to form openings c', d', e'. These openings may constitute interspaces devoid of insulating material, but Buyten does not also show interspaces filled with insulating material.

Sean does not cure the deficiencies of Thoma or Buyten with respect to claim 1. Sean discloses a composition of panels, and makes no mention whatsoever of layers of boards having some interspaces filled with an insulating material and other interspaces are devoid of the insulating material. Therefore, the applied references do not teach or suggest the combination of features recited in independent claim 1.

Claims 2, 3, and 7-10 depend from allowable claim 1, and are allowable at least for the reasons discussed above with respect to claim 1.

Accordingly, Applicants respectfully request that the rejection over claims 1-3 and 7-10 be withdrawn.

Claims 11, 12, and 16-19

While discussing the rejection of claims 1-3, 7-12, and 16-19 on pages 2-3 of the final Office Action, the Examiner states:

Concerning claims 11 and 12-21, these claims are obvious over the prior art for the same reason that claims 1-3 and 7-10 are obvious over the prior art for the reasons set forth in the previous rejection dated 9/14/06 and for the reasons set forth above.

Applicants note that, according to the statement of the rejection on page 2 of the final Office Action, claims 1-3, 7-12, and 16-19 are rejected in view of Thoma/Buyten and Sean. However, the above-noted statement implies that claims 13-15, 20 and 21 are also rejected in view of Thoma/Buyten and Sean. The Examiner's inclusion of claims 13-15, 20, and 21 in the explanation of the rejection of claims 1-3, 7-12, and 16-19 is unclear and confusing. Accordingly, Applicants respectfully request that the Examiner clarify and complete the record with regard to this issue.

Moreover, claims 13-15, 20, and 21 contain features (i.e., at least one plastic mat) not recited in any of claims 1-3 and 7-10. As such, the explanation of the rejection of claims 1-3 and 7-10 fails to establish a *prima facie* case of obviousness with respect to claims 13-15, 20, and 21 because the explanation does not address every feature of the claims. In any event, Applicants submit that none of Thoma, Buyten, or Sean teaches or suggests at least one plastic mat, and, therefore, the applied references fail to teach or suggest each and every feature of claims 13-15, 20, and 21. Therefore, the rejection is improper and should be withdrawn.

With respect to claims 11, 12, and 16-19, Applicants submit that these claims also recite features (and combinations of features) that are not present in claims 1-3 and 7-10. For example, independent claim 11 recites:

- 11. A building board, comprising:
  - an outer layer of first oriented strand boards disposed side by side;
  - an inner layer of second oriented strand boards disposed side by side;
  - first interspaces between the first oriented strand boards; and
  - second interspaces between the second oriented strand boards, wherein the outer layer is connected to the inner layer, and the first interspaces are filled with an insulating material and the second interspaces are devoid of the insulating material.

Moreover, independent claim 16 recites:

- 16. A building board, comprising:
  - an outermost layer of first oriented strand boards disposed side by side;
  - an inner layer of second oriented strand boards disposed side by side;
  - a third layer of third oriented strand boards disposed side by side; and
  - interspaces filled with insulating material in the outermost layer.

Because independent claims 11 and 16 recite different features (and combinations of features) that are not recited in claims 1-3 and 7-10, the explanation of the rejection of claims 1-3 and 7-10, by itself, is insufficient to establish a *prima facie* case of obviousness with respect to claims 11, 12, and 16-19. That is, the Examiner has provided no explanation whatsoever regarding the unique combinations of features recited in claims 11, 12, and 16-19. Therefore, the rejection is improper and should be withdrawn for at least this reason alone.

In any event, Applicants submit that no proper combination of the applied art teaches or suggests all of the features of the claimed invention. None of the applied references teaches or suggests: an outer layer of first OSBs disposed side by side having first interspaces between the first OSBs filled with an insulating material, and an inner layer of second OSBs disposed side by side having second interspaces between the second OSBs devoid of the insulating material, as recited in claim 11. As discussed above, none of the applied references teaches or suggests interspaces between boards filled with insulating material and other interspaces between boards devoid of insulating material.

Moreover, none of the applied references teaches or suggests: an outermost layer of OSBs, an inner layer of OSBs, and a third layer of OSBs, where the outermost layer include interspaces filled with insulating material, as recited in claim 16. None of the applied references

show an outermost layer of OSBs having interspaces filled with an insulating material. Nor has the Examiner identified this feature in any of the applied references.

Claims 12 and 17-19 depend from allowable claims 11 and 16, and are allowable at least for the reasons discussed above with respect to claims 11 and 16.

Accordingly, Applicants respectfully request that the rejection over claims 11, 12, and 16-19 be withdrawn.

*Claims 4, 13-15, 20, and 21 in view of Thoma/Buyten and Sean, and further in view of Ramadan*

Claim 4

Claim 4 depends from allowable claim 1, and is allowable at least for the reasons discussed above with respect to claim 1. Moreover, Ramadan does not compensate for the deficiencies of Thoma, Buyten, and Sean with respect to claim 1. That is, Ramadan does not disclose interspaces, much less some interspaces filled with an insulating material and other interspaces devoid of the insulating material. Therefore, no proper combination of the applied references teaches or suggests the combination of features recited in the claimed invention.

Furthermore, Applicants repeat the argument that there is no motivation to further modify either Thoma or Buyten as suggested in the final Office Action. One of the three basic criteria for establishing a *prima facie* case of obviousness is that there must be a reasonable expectation of success. Applicants submit that there is no reasonable expectation of success for the proposed modification.

As previously discussed, Ramadan discloses a multi-ply panel board with a shaped edge. The board comprises wood layers (col. 2, lines 23-28). An intermediate layer composed of cloth, glass fibers, or plastics is disposed between the wood layers (col. 2, lines 43-48). The edges of

the board are sculpted to expose the intermediate layers as decorative stripes (col. 2, lines 49-53). Put another way, the edge of the board is beveled to show the alternate layers to give a different design to the strip along the beveled edge (col. 3, lines 22-26; and FIG. 3).

Neither Thoma nor Buyten has a beveled edge. Without a beveled edge, merely adding a plastic mat between layers of Thoma or Buyten, as suggested by the Examiner, would not achieve the decorative shaped/sculpted/beveled edge taught by Ramadan. Therefore, there is no reasonable expectation of success, and, thus, no motivation to combine the references.

Accordingly, Applicants respectfully request that the rejection over claim 4 be withdrawn.

#### Claims 13-15, 20, and 21

Claims 13-15 depend from allowable claim 11, and are allowable at least for the reasons discussed above with respect to claim 11. Moreover, the Examiner has failed to establish a *prima facie* case of obviousness with respect to claims 13-15, 20, and 21. The Examiner has provided no explanation of the rejection of claims 13-15, 20, and 21 in view of Thoma, Buyten, Sean, and Ramadan.<sup>1</sup> Therefore, the rejection is improper on its face, and should be withdrawn.

In any event, Applicants submit that no proper combination of the applied references teaches or suggests all of the features of claims 13-15, 20, and 21. As described above with respect to claim 4, there is no motivation to further modify Thoma or Buyten in view of Ramadan. Therefore, the applied references do not render the claimed invention obvious.

Accordingly, Applicants respectfully request that the rejection over claims 13-15, 20, and 21 be withdrawn.

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<sup>1</sup> Applicants note that the Examiner does address features of claim 21 in the explanation of the rejection in view of Thoma, Buyten, Sean, and Ramadan. However, since claim 21 depends from claim 20, and because the Examiner has not addressed claim 20, the explanation of the rejection fails to address all of the features of claim 21.



### CONCLUSION

In view of the foregoing remarks, Applicants submit that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicants hereby make a written conditional petition for extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 19-0089.

Respectfully submitted,  
Joachim HASCH et al.

A handwritten signature in black ink, appearing to read 'Andrew M. Calderon', with a horizontal line drawn underneath it.

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